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PATENT
Attorney Docket No.: SONY-22300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit: 2611
Klaus Hofrichter et al.)	Examiner: Lonsberry, Hunter B.
Serial No.: 09/705,442)	TRANSMITTAL LETTER
Filed: 11/02/00)	162 North Wolfe Road
For: CONTENT AND APPLICATION)	Sunnyvale, California 94086
DOWNLOAD BASED ON A HOME)	(408) 530-9700
NETWORK SYSTEM)	Customer Number 28960
CONFIGURATION PROFILE)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed please find a reply in response to an Examiner's answer mailed on January 30, 2006 for filing with the U.S. Patent and Trademark Office.

The Commissioner is authorized to charge any additional fee or credit any overpayment to our Deposit Account No. 08-1275. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: March 22, 2006

By: Jonathan O. Owens
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Reg. No.: 37,902

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CERTIFICATE OF MAILING (37 CFR § 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

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HAVERSTOCK & OWENS LLP.
Date: 3-22-06 By: Nicholas Owens



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

Klaus Hofrichter et al.)

Serial No.: 09/705,442)

Filed: November 2, 2000)

For: **CONTENT AND APPLICATION**)
DOWNLOAD BASED ON A)
HOME NETWORK SYSTEM)
CONFIGURATION PROFILE)

Group Art Unit: 2611

Examiner: Lonsberry, Hunter B.

**REPLY BRIEF IN RESPONSE TO
EXAMINER'S ANSWER**

162 N. Wolfe Rd.
Sunnyvale, CA 94086
(408) 530-9700
Customer No. 28960

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed on January 30, 2006, this Reply Brief is hereby submitted to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.41. Claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62 and 64-66 (including the independent claims 1, 28, 38 and 56) have been rejected.

The Examiner has relied on references that are improperly combined. The burden of establishing a *prima facie* case of obviousness has not been met to support the rejections. Furthermore, in answering Appellants' Appeal Brief, Examiner did not adequately address a number of Appellants' arguments.

Appellants contend that the rejection of Claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62 and 64-66 is in error and should be overcome by the appeal in the application referenced above. Appellants further contend that the Edson, Tracton and Shteyn patents, applied either separately or together, do not support the rejection of Claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62 and 64-66. Further, the combination and application of these references is improper in the instant case. In view of the foregoing, Appellants respectfully submit this Reply Brief, wherein:

the **STATUS OF THE CLAIMS**, begins on page 2;

the **GROUND FOR REJECTION**, begin on page 3; and

ARGUMENTS, begin on page 4 of this paper.



STATUS OF THE CLAIMS

Claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62 and 64-66 are pending in this case.

Claims 1-7, 10, 12-14, 18-21, 28-34, 37-44, 56-62 and 64-66 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,526,581 to Edson (hereinafter Edson) in view of U.S. Patent 6,470,378 to Tracton (hereinafter Tracton).

Claim 11 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Edson in view of Tracton in further view of U.S. Patent No. 6,618,764 to Shteyn (hereinafter Shteyn).

Within the Appeal Brief, Claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62 and 64-66 are appealed.

GROUND OF REJECTION AND MATTERS TO BE REVIEWED ON APPEAL

The following issues were presented in the Appeal Brief for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1-7, 10, 12-14, 18-21, 28-34, 37-44, 56-62 and 64-66 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Edson (hereinafter, Edson) in view of Tracton.
2. Whether claims 11 is properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Edson in view of Tracton in further view of Shteyn.

ARGUMENT

I. SUMMARY OF THE CLAIMED INVENTION

The invention disclosed in the present application number 09/705,442 is directed to a system and method for downloading selected multimedia content and applications based on a home network system configuration profile. The system and method taught in the present application identifies, accesses and manages service applications for use with associated consumer electronic devices in a home network system. A client side process, executed by a client computing system in the home network system, operates in conjunction with a server side process executed by a server via the Internet. The client computing system is implemented by a gateway device communicatively coupled with each of the electronic devices via the home network. The gateway device is operative to access the Internet and is communicatively coupled with a display unit.

Each of the claims being appealed includes a limitation specifying automatically downloading an application associated with a device within a network from a server based on the *provided home network configuration profile*. As will be discussed in detail below, the cited references do not disclose, teach, or even suggest automatically downloading an application associated with a device within a network from a server based on the *provided home network configuration profile*.

II. THE CITED REFERENCES DO NOT DISCLOSE, TEACH, OR EVEN SUGGEST EACH AND EVERY ELEMENT OF THE CLAIMS

Appellants respectfully submit that the cited references, including Edson, Tracton and Shteyn simply do not disclose, teach, or even suggest automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*.

Edson teaches a multi-service in-home network with an open interface. Edson teaches using a gateway providing an open software interface to control in-home communications and to enable in-home devices of various divergent technologies to selectively access external communication features. [Edson, col. 5, lines 27-30] Edson teaches that the use of an open interface enables many different types of devices to communicate, and when desired, to access external communication resources through the in-home network media and the centralized gateway. [Edson, col. 5, lines 30-35] As recognized within the Office Action dated November 18, 2004, Edson does not teach determining device identification information for the devices within the network and providing a configuration profile to a remote server. [Office Action mailed November 18, 2004] Edson also does not teach automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*.

Furthermore, Edson teaches that diagnostics or software downloads could be automatic, but Edson does not teach automatic diagnostic software downloads as is claimed in the present invention. [Edson, col. 11, lines 37-40] Edson does not teach automatically downloading an application from the server to the home network, the application being operative to provide to the or each electronic device, a control application, an interface application, a device interplay application, a support application, a diagnostic application, or a maintenance application.

Tracton teaches dynamic content customization in a client server environment. Tracton teaches that the server sends a query to the client, requesting the client to identify its capabilities. [Tracton, col. 3, lines 55-58]. Tracton further teaches that the client then sends to the server a characteristic profile indicating to the server the client's available computing resources and network bandwidth. [Tracton, col. 3, lines 58-62] Tracton teaches that the server then is able to prepare or direct the client to appropriate resources. [Tracton, col. 3, lines 62-65] Tracton does not teach determining device identification information and a configuration profile for electronic devices within a *home network system*. Tracton only teaches that the client provides its own characteristic profile to the server. Unlike the characteristic profile of Tracton which includes

computing resources and network bandwidth which are used generally for determining speed, the *configuration profile* of the present invention includes device identification information, home network user preferences, history of use, storage capacity, security capabilities as well as resources and bandwidth. The characteristic profile of Tracton is not interchangeable with the *configuration profile* of the present invention. Tracton also does not teach automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*. According to the Examiner's answer, page 13, Tracton teaches downloading differently formatted MPEG streams. MPEG streams are simply video data, not applications. Accordingly, Tracton does not teach downloading an application based on the provided home network configuration profile.

On pages 12-15 of the Examiner's Answer, the Examiner argues that Edson and Tracton, in combination with Examiner's official notice, teach a home network configuration profile. Appellants respectfully disagree. The Examiner's arguments still do not show how Edson, Tracton, the official notice or their combination teach or suggest: (i) determining device identification information and a *configuration profile* for electronic devices within a *home network system*; or (ii) automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*. Within the Examiner's Answer it is recognized that "Edson specifically fails to teach providing a profile based on device identification to a server, wherein the server is remote from the home network and then based upon the profile downloading an application." [Examiner's Answer pages 12-13] But the profile that the Examiner says Tracton discloses is *device-specific* and is not a *home network configuration profile*. Furthermore, Tracton discloses downloading differently formatted MPEG streams, which are simply video files, not applications. Hence, it is very clear that Edson, Tracton, the official notice and their combination do not teach or suggest: determining device identification information and a *configuration profile* for electronic devices within a *home network system* nor automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*.

Described in section III below, the combination of Edson and Tracton is not proper. But, even if it were proper to combine Edson and Tracton, the combination still does not teach determining device identification information and a *configuration profile* for electronic devices within a *home network system*. Edson, Tracton and their combination also do not teach automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*. In contrast to the teachings of

Edson, Tracton and their combination, the present invention is directed to a system and method for identifying, accessing and managing service applications for use with associated devices in a network of devices. A device within the network of devices determines device identification information associated with the devices in the network of devices, determines a *network system configuration profile* based on the device identification information and provides the *configuration profile* to a remote server. The server determines an application operative to provide a process associated with devices within the network of devices and communicates that application to the device. The device executes the application to provide a remote interactive process associated with the devices. This interaction between the device and the server is performed automatically, without user intervention. As discussed above, neither Edson, Tracton nor their combination teach determining device identification information for devices within a network and providing a configuration profile to a remote server. Further, neither Edson, Tracton nor their combination teach executing an application at a device within a network of devices that was received from a server and is used to provide a remote interactive process with devices in the network of devices. Further, neither Edson, Tracton nor their combination teach automatically downloading an application from a server associated with a device within a network.

Appellants respectfully direct the Board's attention to the guidance provided by the Federal Circuit below:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification" (emphasis added) (In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) (see also In re Fitch, 972 F.2d 1260 (Fed. Cir. 1992))).

In a proper obviousness determination, "whether the changes from the prior art are 'minor', ... the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's ... device." (citations omitted.) This includes what could be characterized as simple changes, as in *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down). (emphasis added) (In re Chu, 66 F.3d 292, 298 (Fed. Cir. 1995))).

Neither Edson, Tracton nor their combination disclose, teach or even suggest determining device identification information and a *configuration profile* for electronic devices within a *home network system*. Neither Edson, Tracton nor their combination teach automatically downloading an application associated with a device within a network from a server *based on the provided*

home network configuration profile. Therefore, it is improper to view the present invention as obvious.

The combination of Edson and Tracton does not teach the present invention, as claimed. As discussed above, Edson teaches a multi-service network with an open interface. Edson does not teach determining device identification information for the devices within the network and providing a *configuration profile* to a remote server. Tracton does not teach determining device identification information and a *configuration profile* for electronic devices within a *home network system*. Tracton teaches that a client provides only its own characteristic profile to a server. Furthermore, Tracton teaches downloading MPEG streams, not an application. Accordingly, neither Edson, Tracton nor their combination teach determining device identification information for devices within a network and providing a *configuration profile* to a remote server. Further, neither Edson, Tracton nor their combination teach automatically downloading an application associated with a device within a network from a server *based on the provided home network configuration profile*.

The burden of establishing a *prima facie* case of obviousness based on the teachings of Edson and Tracton has not been met by the Examiner because these references, either singularly or in combination, do not disclose all claim limitations in each of Appellants' independent claims, and because there is no suggestion or motivation to combine or modify these references.

III. THE COMBINATION OF THE CITED REFERENCES IS IMPROPER

Among the three well-established criteria to establish a *prima facie* case of obviousness, it is settled that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Although Edson and Tracton are both found in the field of Electronic Arts, that alone, is not enough to justify their combination. It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference, or references, must teach or suggest all the claim limitations. MPEP § 2143.

There is no motivation to combine the teachings of Edson with Tracton. As discussed above, Edson relates to a multi-service network with an open interface. Tracton is not directed to communications between a server and a device within a network of devices, but only to communications between a server and a client. Tracton is also not directed to downloading applications; rather, Tracton is directed to streaming videos.

This is a classic case of impermissibly using hindsight to make a rejection based on obviousness. The Court of Appeals for the Federal Circuit has stated that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In Re Fritch, 972 F.2d, 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). As discussed above, Edson teaches a multi-service network with an open interface. Tracton is not directed to communications between a server and a device within a *network of devices*, but *only* to communications between *a server and a client*. Moreover, Tracton only teaches downloading MPEG streams, not applications. Streaming video, such as MPEGs, is not equivalent to downloading applications. There is no hint, teaching or suggestion in any of these references to warrant their combination. Further, neither Edson, Tracton nor their combination teach or make obvious determining device identification information for devices within a network and providing a *configuration profile* to a remote server. To conclude that this is obvious based on the teachings of these references is to use hindsight based on the teachings of the present invention and to read much more into Edson and Tracton than their actual teachings. This is simply not permissible based on the directive from the Court of Appeals for the Federal Circuit.

Within the Examiner’s Answer, there is no additional motivation suggested to combine the references. All that is stated is that “it would have been obvious to one skilled in the art at the time of the invention to modify Edson to utilize the profile, which includes device identification, transmit it to a server and download an application as taught by Tracton, for the advantage of downloading applications which are specifically tailored to the needs and capabilities of the client device.” [Examiner’s Answer, page 18] Furthermore, the Examiner states “motivation to combine was not found in Applicant’s disclosure.” [Examiner’s Answer, page 18] Thus, no justification for the combination was given. The Examiner simply concluded that the combination makes the present invention obvious, but there is no reasoning provided as to why the combination is valid in the first place. Moreover, considering the Examiner’s assertions on page 13 of the Examiner’s Answer that “MPEG streams” are downloaded in Tracton, the Examiner’s contentions that applications are downloaded in Tracton is simply incorrect. Tracton does not teach downloading applications. Tracton teaches streaming MPEG

video. This is another example of the Examiner stretching Edson and Tracton to create the present invention impermissibly using the knowledge of the present invention.

By justifying the combination with the result of the combination, this result being the advantages of the presently claimed invention, it is clear that the combination of Edson and Tracton has been based on hindsight. Only with the presently claimed invention as a template would one find the “motivation” or result provided within the Office Action. Accordingly, the combination of Edson with Tracton is improper.

Furthermore, “[t]he test for an implicit showing [of a teaching, suggestion or motivation] is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Moreover, “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” Kotzab at 1371.

In the present case, as in Kotzab, there are no showings of particular findings that a skilled artisan, with no knowledge of the claimed invention, would have selected the components from Edson and Tracton for combination in the manner claimed. As discussed above, Edson teaches a multi-service network with an open interface. Tracton is not directed to communications between a server and a device within a *network of devices*, but *only* to communications between *a server and a client*. This is comparable to the court in Kotzab rejecting the argument that one sensor was the same as one system and stating that there was no finding as to a specific understanding or principle that would have provided the motivation to use a single sensor as a system to control more than one valve. The court did not allow a system to be interchanged with a sensor nor should the present Board allow a server and a client be interchanged with a network of devices. To conclude that this is obvious based on the teachings of these references is to use hindsight based on the teachings of the present invention and to read much more into Edson and Tracton than their actual teachings.

IV. CONCLUSION

Each of the claims pending within this appeal include limitations specifying determining device identification information for devices within a *network* and providing a *configuration profile* to a remote server. The claims also include limitations specifying automatically downloading an *application* associated with a device within a network from a server based on the provided *home network configuration profile*. There is nothing in the teachings of the cited

references that support the rejections of claims with such limitations. To support the rejection of the pending claims, the Examiner has made an attempt to provide some motivation to combine and cure the defects in each of the cited references. As discussed in detail above, however, even if the combination of the many cited references is permissible, the references and their combination do not disclose, teach, or even suggest the limitations of the pending claims. Moreover, their combination is improper and improperly applied as the basis of a §103 rejection. In view of the foregoing, it is respectfully submitted that Claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62 and 64-66 (including the independent claims 1, 28, 38 and 56) are allowable over the teachings of the cited references. Therefore, review of this appeal and a favorable indication is respectfully requested.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: March 22, 2006

By: Jonathan O. Owens
Jonathan O. Owens
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CERTIFICATE OF MAILING (37 CFR § 1.8(a))

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HAVERSTOCK & OWENS LLP

Date: 3-22-06 By: Nicole K. [Signature]